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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,158	06/30/2000	William J. Veeneman	9203/046 RE	3096

24283 7590 02/20/2002

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PO BOX 270930
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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 02/20/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary

Application No.

09/610,158

Applicant(s)

VEENEMAN ET AL.

Examiner

Thomas A. Dixon

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

1. Claims 1-29 are rejected because the oath or declaration is defective. The oath or declaration is defective, it is not, in fact a Reissue Oath/Declaration. A new oath or declaration in compliance with 37 CFR 1.175 and MPEP §§ 1414 is required.

The oath or declaration is defective because:

- a) The reissue oath/declaration filed with this application is defective because it fails to state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. The rule does not contain the terms "substantial likelihood... reasonable examiner..."
- b) The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
- c) The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Surrender of Patent

2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Information Disclosure Statement

3. Examiner requests that applicant file IDS with all art cited in the parent cases, and specifically requests copies of the non-patent literature as it appears to have been lost from the file.

Assent of Assignee

4. The Statement under 3.73(b) which establishes the right of the assignee to take action cannot be located, please resubmit.

Improper Recapture

5. Claims 1-29 are rejected under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement* 131 F.3d 1464, 45 Uspq2d 1161 (Fed. Cir 1997); *Ball Corp. V United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984), A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Applicant's broadening of the claims has been considered in light of the prosecution of the parent cases and is seen to be improper recapture. Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas. Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture.

Drawings

6. This application has been filed with drawings which are acceptable for examination purposes only and have been objected to by the draftsman. Formal drawings will be required when the application is allowed.

Additional Prior Art Cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wakatsuki et al ('438) discloses an input device which associates two pieces of data, item bar code and number of the items, for such purposes as inventory, but does not specifically disclose an input device storing merchant id associated with the bar coded item, as claimed.

Bianco ('614) discloses a system and method for home shopping for groceries for delivery or later pickup at the store, which may imply identification of a merchant and the merchant's location, but does not specifically disclose input device storing merchant id associated with the bar coded item.

Gombrich ('441) discloses a portable terminal and bar code reader for use in the healthcare environment, but does not specifically disclose input device storing merchant id associated with the bar coded item.

WO 94/27226 to Veeneman et al is the closest foreign art, but is applicant's own work.

Chain Store Age Executive's Here Comes the (New) Bridal Registry discloses a system for gift registry very like applicant's invention, but does not specifically disclose input device storing merchant id associated with the bar coded item.

Allowable Subject Matter

8. Claims 1-29 are allowable over the prior art of record.

As per Claims 1, 9, 13, 15, 20, 25.

The prior art of record, specifically Chain Store Age Executive in view of Bianco (5,047,624), does not specifically disclose the portable input and storage device for use with a plurality of participating merchants stores a unique identifier for the particular merchant each desired gift is from.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7293 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Thomas A. Dixon
Examiner
Art Unit 2161

February 8, 2002